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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758.667

01/14/2004

Steven J. Boege

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09/13/2006

MILA KASAN, PATENT DEPT.
APPLIED BIOSYSTEMS
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EXAMINER

PUNNOOSE, ROY M

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,667	BOEGE ET AL.	
	Examiner	Art Unit	
	Roy M. Punnoose	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 22 is/are allowed.
- 6) ☒ Claim(s) 11 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/14/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-14 and 19-22 in the reply filed on July 10, 2006 is acknowledged. Accordingly, claims 15-18 have been withdrawn from consideration and cancelled. Claims 1-14 and 19-22 are pending in the application.

Information Disclosure Statement

2. The I.D.S. filed on April 03, 2006 indicates that there are two pages in the filing. However the Office has only the first page on record, a signed and initialed copy of which is included herewith. The applicant is requested to correct this error in response to this office action

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the pupil of the camera as described in the specification and claimed in the claims. The drawings show neither the camera nor the pupil of the camera. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "a first optical device" on line 3, and on line 7 creates doubt as to whether reference is made to a single "first optical device" or if reference is made to two different/separate "first optical device." The two references to "a first optical device" in the claim are misleading. Appropriate correction is required.
6. Claim 11 recites the limitation "the pupil of the camera" in line 20. There is insufficient antecedent basis for this limitation in the claim. There is no prior reference of a pupil or a camera in the claim. Appropriate correction is required.
7. Claim 19 recites the limitation "the pupil of the camera" in line 11. There is insufficient antecedent basis for this limitation in the claim. There is no prior reference of a pupil or a camera in the claim. Appropriate correction is required.

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8. Claim 19 recites the limitation "the second wavelength band and the fourth wavelength band" in line 10. There is insufficient antecedent basis for this limitation in the claim. There is no prior reference of a "second wavelength band" or a "fourth wavelength band" in the claim. Appropriate correction is required.

9. Claim 19 recites the limitation "the thermal cycling" in line 15. There is insufficient antecedent basis for this limitation in the claim. There is no prior reference of "thermal cycling" in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

10. The 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 19 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. Claim 19 is rejected because it is claiming a non-tangible result. In claim 19, merely determining the concentration of each spectrally distinguishable species would not appear to be sufficient to constitute a useful, concrete and tangible result, since the outcome of the determining step has not been used in a disclosed practical application nor made available (in the claim) in such a manner that its usefulness in a disclosed practical application can be realized.

See OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

The applicant is requested to determine whether the claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. Sec. 101, sentence 3, in the OG Notice from 22 November 2005, which states "In determining whether the claim is for a practical application,

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the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible, and concrete.”

13. Claims 20 and 21 are rejected for reasons similar to the reasons of rejection of claim 19 above because they are not claiming a useful, concrete and tangible result and therefore are directed to non-statutory subject matter because they are dependent on claim 19 and they comprise intermediate step(s) in the method of determining the concentration of each spectrally distinguishable species, claimed in claim 19.

Note: Please note that in claim 1, the recitation “wherein the device *provides a data signal* representative of the concentration of spectrally distinguishable species based on the intensity of fluorescent light emitted by the samples” provides a final result that is useful, tangible, and concrete. Similarly, in claim 11, “generating a data signal” provides a final result that is useful, tangible, and concrete.

Allowable Subject Matter

14. Claims 1, 11, 19 and 22 have allowable subject matter.

15. Claims 11 and 19 would be allowable if amended to overcome the 35 U.S.C. 112 and the 35 U.S.C. 101 rejections respectively as detailed above.

16. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if the base claim is amended to overcome the rejection.

17. Claims 1, 11, 19 and 22 would be allowable because the prior art of record, taken alone or in combination, fails to disclose or render obvious a fluorometry method/apparatus for determining the concentration of spectrally distinguishable species in a biological sample comprising moving a movable platform comprising a plurality of optical devices adapted to filter

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the source beam/excitation light and to filter the fluorescent light from the samples, in combination with the rest of the limitations of the respective claims.

18. Claims 2-10 are allowable because they are dependent on independent claim 1.

Contact/Status Information


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**.

The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 10, 2006


Roy M. Punnoose
Patent Examiner
Art Unit 2877